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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/047,837
Filing Date: January 16, 2002
Appellant(s): HIMMEL ET AL.

Jeffrey L. Streets

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/6/06 appealing from the Office action mailed 11/4/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20040111669	Rossmann et al.	6-2004
20020022923	Hirabayashi	2-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1-2, 5-10, 21-24, 26-28, 31-33, 35 and 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Rossmann et al. (hereafter "Rossmann") [U.S. 20040111669].

As to claim 1, Rossmann teaches the invention as claimed including: a method for sending a telephone number record into a communications terminal [e.g., 301, Fig.3] comprising:

recording in a web browser a destination address of the communications terminal having the electronic telephone directory [e.g., at paragraph 2, Rossmann teaches that favorite web pages (i.e., URLs or websites) can be saved as a list of bookmarks; at paragraphs 60-63,

Rossmann teaches that through selected "related operations", phone numbers identified and extracted from a web page can be saved into a PIM (Personal Information Manager); at paragraphs 69-70 and 76-78, Rossmann further teaches that a user may manually set preferred websites or locations to perform the "related operations", which means that the extracted phone numbers can be entered into a PIM at a location (i.e., URL) designated by the user via pre-selected URL];

capturing one or more telephone number records from a Web page [paragraphs 44-45, 60-63, 68 and 78; e.g., saving a captured telephone in a PIM or a telephone book, wherein the act of selecting one or more telephone numbers may be accomplished by invoking the related operations];

sending a message containing the one or more captured telephone number records from a captor to the destination address of the communications terminal [e.g., Abstract and claim 17; that is, in Rossmann's system either the browser of the communication terminal or the servers 308 or 316 of Fig.3 can be used for saving the phone numbers into a local PIM].

[Note that although Rossmann uses the "weather site" example to show how a user may set preferences (known as bookmarks in a browser) for the "related operations" (or web service), the teaching is equally applicable to the example of saving phone numbers into a PIM. Note further that in paragraphs 95-98, Rossmann teaches another scenario wherein the browser application performs scanning and classification of a webpage (that contains desired data items), resulting in a markup language deck as shown in the example of paragraph 97. The fact that the browser application forms a markup language deck (such as the one shown in paragraph 97) is an

act of "recording a destination address in a browser" because the selectable PIM destination addresses are recorded in the deck.]

As to claim 2, Rossmann further teaches receiving the message containing the one or more captured telephone number records from the captor computer; and recording the one or more telephone number records into the electronic telephone directory [e.g., paragraphs 60-63 and claim 17; note that the extracted phone numbers and the "related operations" together form a message, which is sent to the communication terminal for saving the phone numbers into a local PIM].

As to claims 5-6, Rossmann further teaches that the communications terminal is selected from a mobile telephone, a personal computer, a voice mail messaging service, a FAX machine, a handheld computer, a personal digital assistant or combinations thereof, wherein the communications terminal is selected from a device that can store and retrieve information and is connectable to a telephone network [e.g., 301, Fig.3 or 400, Fig.4].

As to claim 7, Rossmann further teaches that the destination address for the communications terminal is selected from a computer network address, an Internet address or a telephone number [e.g., paragraphs 69 and 78; i.e., the URL is an Internet address designating where the extracted phone numbers are to be stored in a local PIM].

As to claims 8-9, Rossmann further teaches that the one or more telephone number records comprises a telephone number and an alphanumeric identifier for the telephone number,

wherein the telephone number record comprises parameters selected from a telephone number, a contact name, an address, a FAX number, an e-mail address, a hyperlink to a Web site, a business name, a business specialty, business hours or combinations thereof. [paragraphs 64-68; i.e., when the data type is a "person", then a telephone number is associated with the person's name and other attributes such as address, which are alphanumeric identifiers for the telephone number when uses the person's name or address as a key to extract the phone number from the PIM records or database].

As to claim 10, Rossmann further teaches that the step of recording the destination address comprises:

a. selecting a menu function on the browser for recording the communications terminal's destination address;

b. specifying the destination address on an interactive display provided by the browser; and

c. saving the destination address within the browser program.

[Note that steps a-c are inherent procedures for recording a communications terminal's destination address in a bookmark accessible by the browser].

As to claims 21-24, 26-28, 31-33, 35 and 37-39, since the features of these claims can also be found in claims 1-2, 5-7 and 9, they are rejected for the same reasons set forth in the rejection of claims 1-2, 5-7 and 9 above.

As for the additional limitations requiring the use of a computer program product for performing the steps of claim 27: see Rossmann's teaching in paragraph 99 and claims 18-29.

As for the additional limitation requiring "downloading a Web page containing a telephone number record tailored for the geographical location of the destination address": it is noted that a telephone having an area code [see the listed telephone number in paragraph 88] is in a form "tailored for the geographical location of the destination address" because the associated area code makes it possible to make a call from anywhere in the country.

Claim Rejections - 35 USC § 103

Claims 3-4 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et al.(hereafter "Rossmann")[U.S. 20040111669], as applied to claims 1-2, 5-12, 21-24, 26-28, 31-33, 35 and 37-39 above, further in view of Official Notice.

As to claim 3, Rossmann further teaches that the selected data type (such as telephones) contained in a web page can be extracted and stored in a telephone book (PIM) via a set of user selected operations [e.g., paragraph 81: "For example, for a "phone number" data type, there might exist operations to perform areverse lookup on a phone number, add the phone number to a PIM, etc."].

Rossmann does not specifically teach the detailed procedures as to how the selected operations include: searching the existing electronic telephone directory to see if the number to be entered already exist or not, and if it does, then notify the user of the existence.

However, Official Notice is taken that this additional feature is well known in the art. For example, a user is warned when an attempt to overwriting a record of a file is made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to follow this conventional procedure to update Rossmann's telephone directory because the procedure ensures the integrity of the directory.

As to claim 4, Rossmann does not specifically teach how a telephone record in the telephone directory is updated (e.g., deleting, adding, or modifying a record).

However, Official Notice is taken that the listed feature is a typical procedure in the art of updating a PIM record or a database.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to adopt the conventional updating procedure in updating Rossmann's PIM because such procedure ensures the integrity of the PIM.

As to claims 16 and 29-30, since the features of these claims can also be found in claims 1, 3-4 and 27, they are rejected for the same reasons set forth in the rejection of claims 1, 3-4 and 27 above.

Claims 11, 13-15, 18-20, 25, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et al. [U.S. 20040111669], as applied to claims 1-11, 21-24, 26-33, 35 and 37-39 above.

As to claims 11 and 15, Rossmann teaches automatically capturing telephone numbers from a web page to a telephone directory such as PIM (personal Information Manager). Rossmann does not specifically teach the option of displaying a telephone number record dialogue box; and receiving an instruction from a user identifying the one or more the telephone number records to capture.

However, the above telephone entering method is obvious in operating a PIM in its nominal mode [e.g., paragraph 9]. That is, by manually entering the telephone numbers to be entered in a dialog provided by the PIM and instruct the PIM to save the telephone numbers into its local database. Thus, it would have been obvious to maintain this manual option to the user, because this is a complementary method for entering data into a user's PIM [note that claim 1 allows the captor computer to be the destination of the captured telephone destination – meaning that the user who browses the web page is also the owner of the PIM].

As to claims 13-14, Rossmann further teaches that the telephone number record comprises a telephone number and an alphanumeric identifier for the telephone number [e.g., the telephone owner's name], the method further comprising:

d. editing the alphanumeric portion of the chosen telephone number record, wherein the editing better identifies the telephone number [e.g., it is easier to locate a telephone by associating the telephone number with its owner's name];

e. editing the telephone number portion of the chosen telephone number record,

wherein the telephone number record is displayed in a standard format suitable for a format of the electronic telephone directory.

[Note that steps d and e are nominal procedure of editing a PIM record wherein the alphanumeric identifier is the person's name, and the phone number and address are the attributes of the name. See also paragraphs 64-68 for more details as how a telephone number may be part of the attributes of a person in a PIM].

As to claims 18-19, Rossmann does not specifically teach marking the message with a password which is recorded on the browser with the destination address of the communications terminal, and determine that the message contains a telephone directory record, discarding the message if the message is not marked with a password.

However, it is well known in the art of secured communication for only allowing a message marked with authentication information (such as a password) to be transferred to a destination.

It would have been obvious to one of ordinary skill in the art that, when the communication terminal is situated in a secured network or the user's PIM is to be securely guarded, Rossmann's message (which include captured telephone numbers and instructions to updating the same) needs to be authenticated because by doing so it enhances the integrity of the local telephone directory by preventing the telephone records from being modified by an unauthorized person.

As to claim 20, Rossmann teaches that the PIM destination of the captured telephone numbers can be located at a remote website or a remote communications terminal [e.g., claim

17]. Rossmann does not specifically teach providing notification that the message has arrived at the destination address.

However, sending a notification or acknowledgement to the originator of a message that the intended information has been securely transferred is obvious in the art [e.g., a TCP protocol employs retransmission mechanism for a lost packet]. It would have been obvious to one of ordinary skill in the art that Rossmann's system may adopt the similar protocol because it enables the sender to retransmit a message if it is determined that the message has been lost.

As to claims 25, 34 and 36, since the features of these claims can also be found in claims 1, 11, 13, 16, 21 and 27, they are rejected for the same reasons set forth in the rejection of claims 1, 11, 13, 16, 21 and 27 above.

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(10) Response to Argument

As to claims 1, 21, 27 and 37, Applicant argues that Rossmann does not teach the claimed features because: (1) Rossmann's bookmark is for recording the addresses of desired web pages, rather than the destination of a terminal having a telephone directory; (2) Rossmann's system does not save telephone numbers captured (and sent as a message) from a captor computer; (3) Rossmann does not teach a computer program product having instructions for

sending the aforementioned message to an electronic telephone directory at a destination address (claim 27); and (4) Rossmann does not teach or suggest that the server hosting the Web page is capable of sending a message to a communications terminal identified by a destination address in the user's Web browser (claim 37).

Applicant's argument is not deemed to be persuasive. As to points (1) and (2), Applicant is reminded that a browser's bookmark could store not only simple URLs leading to the fetch of respective web pages, but also sophisticated URL statements such as the two exemplified URLs listed in the HTML deck of paragraph 97, leading to invocation of respective web services. From the cited passages at paragraphs 2, 60-63, 69-70 and 76-78, Rossmann clearly teaches that the website or servers for performing the selected "related operations" (i.e., responding to the message containing the captured phone numbers and the related operations – by saving the captured phone numbers into a PIM) could be stored as a list of user's preferences. Take the task of "obtaining weather information from a selected website" as an example, the two choices of URLs contained in the markup language deck of paragraph 97 can be pre-saved in two bookmark locations of a browser. A user could then select a URL from the bookmark to extract weather information.

Note that although Rossmann uses the "weather site" example to show how a user may set preferences (known as bookmarks in a browser) for the "related operations" (or web service), the teaching is equally applicable to the example of saving phone numbers into a PIM.

It is further noted that in paragraphs 95-98, Rossmann teaches another scenario wherein the browser application performs scanning and classification of a webpage (that contains desired data items), resulting in a markup language deck as shown in the example of paragraph 97. The

fact that the browser application forms a markup language deck (such as the one shown in paragraph 97) is an act of "recording a destination address in a browser" because the selectable PIM destination addresses are recorded in the deck.

For at least the above reasons, it is submitted that Rossmann teaches at least two scenarios of pre-recording the destination address of a communication terminal, from which instructions are given to store the captured telephone number into a telephone directory (i.e., the PIM). One is to pre-store the destination addresses as bookmarks of a browser. Another scenario is using the browser application to form an HTML deck for a user to invoke a web service location. Either scenario would read on the claims.

As for the additional variations in claims 21, 27 and 37, see the rejection at the end of the 102 rejection section above.

As to claims 3 and 29 (and their dependent claims), Rossmann fails to teach: (1) recording the number if it did not exist in the telephone directory; and (2) providing notification to the user if the number already exists in the directory, and the examiner's Official Notice is not commensurate in scope with these rejected claims.

Applicant's argument is not deemed to be persuasive. In paragraph 81, Rossmann teaches a similar two-steps procedure: "reverse lookup" of a telephone (which may obviously include checking if a telephone number already exists); and add the phone number to a PIM (which may include alerting the user that the existing phone may be overwritten by the new one). The claimed features are obvious and well known in data/file updating procedure associated with a filesystem, PDA, PIM or database. The examiner's Official Notice simply expresses the nature

of such "notorious" obviousness that an ordinary skilled artisan could employ the same in Rossmann's system to prevent unintended modification of an existing telephone record in the PIM. As an evidential support for the Official Notice, Applicant is direct to paragraph 21 of Hirabayashi [US PGPub. 20020022923], which includes the aforementioned check and alert steps.

It is further noted that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference ... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

As to claims 11 and 15, the examiner fails to address the claimed feature by citing paragraph 90 of Rossmann.

Applicant's argument is not deemed to be persuasive. It is noted that paragraph 90 was cited to point out that Rossmann's system also employs user interface (UI) for allowing user to enter selection via an interface menu established for the related operations. In this instant office action it is also shown that the claimed dialog capability appears to be typical of a data entry procedure with a PIM, wherein a user typically enters data items via a dialogue box. Since claim 1 allows the PIM and the browser to be co-located at the captor computer, it maintains an option that the user may manually enter the captured telephone numbers into the PIM via a dialogue box. Similar teaching may also be found in paragraph 9.

As to claims 13-14, the examiner refers rejection of these claims to that of 7-8, but it is not clear how the paragraphs cited against claims 7-8 would provide teachings of the limitations of claims 13-14.

Applicant's argument is not deemed to be persuasive.

Applicant is reminded that the rejection of claim 8 cites paragraphs 64-68 to show that Rossmann's telephone number could be associated with a person's name who owns the telephone number, wherein the person's name functions as an alphanumeric identifier of the telephone number, and the name also make it a better key to access the telephone number from the PIM database.

As to claims 18-20, the examiner appears to be taking Official Notice regarding making a message with a password without specifically stating that Official Notice is involved. Furthermore, the examiner fails to cite any evidence to support his rejection on these claims.

Applicant's argument is not deemed to be persuasive. Applicant is reminded that claims 18-20 and other dependent claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann. In the rejection the examiner uses the prior art of Rossmann in additional to the knowledge generally available to one of ordinary skill in the art, rather than taking the Official Notice (see MPEM 2144). The motivation of combining these two sources of teaching is clearly stated in the text associated with the rejections of claims 18-20. There is no confusion on the examiner's part that claims 18-20 were not rejected by taking Official Notice.

As to claim 17, Applicant's argument is persuasive, therefore the rejection of this claim has been withdrawn.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Wen-Tai Lin 11/16/06

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